

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 020375-032410US	
I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office on <u>April 29, 2008</u> . TOWNSEND and TOWNSEND and CREW LLP By: <u>/Janet L. Newmaker/</u> Janet L. Newmaker	Application Number 10/675,929		Filed September 29, 2003
	First Named Inventor Charles Whitaker et al.		
	Art Unit 3626	Examiner Kristine K. Rapillo	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,358</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____ </div> <div style="width: 45%; text-align: center;"> <u>/Irvin E. Branch/</u> _____ Signature <u>Irvin E. Branch</u> _____ Typed or printed name <u>303-571-4000</u> _____ Telephone number <u>April 29, 2008</u> _____ Date </div> </div>			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

<input checked="" type="checkbox"/> *Total of <u>1</u> form is submitted.

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PATENT
Attorney Docket No.: 020375-032410US

TOWNSEND and TOWNSEND and CREW LLP

By: /Janet L. Newmaker/
Janet L. Newmaker

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Charles Whitaker et al.

Application No.: 10/675,929

Filed: September 29, 2003

For: Systems And Methods For
Verifying Medical Insurance
Coverage

Customer No.: 20350

Confirmation No.: 2374

Examiner: Kristine K. Rapillo

Art Unit: 3626

PRE-APPEAL BRIEF
REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Applicants request review of the final rejection for the above-identified application. A response after final was filed on March 31, 2008. No amendments to the claims are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated herein.

REMARKS/ARGUMENTS

Claims 1-9, 11, 12, 14-16 and 22-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,012,035 to Freeman, Jr. et al. (“Freeman”) in view of the cited portions of U.S. Patent No. 4,491,725 to Pritchard (“Pritchard”). Claims 10, 13, 19, 20 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Pritchard as applied to claims 1 and 11, and further in view of the cited portions of U.S. Patent No. 5,070,452 to Doyle, Jr. et al. (“Doyle”). Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pritchard in view of Doyle. Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Pritchard and Doyle as applied to claim 20, and further in view of the cited portions of U.S. Patent No. 6,108,641 to Kenna et al. (“Kenna”).

Rejections Under 35 U.S.C. § 103

The Applicants respectfully request review of the pending rejections. The cited references do not teach or suggest all elements of the pending claims, thereby rendering the rejections invalid for failure to establish a prima facie case of obviousness. The Applicants’ arguments are set out in further detail hereinafter.

The rejection of claim 1 is believed to be invalid because the cited references do not teach or suggest “receiving at a financial transaction processing computer system a member identifier relating to the member” nor do they teach “transmitting from the financial transaction processing computer system authorization information.” Neither Freeman nor Pritchard teach or suggest a computer that processes financial transactions being used to verify medical insurance coverage. Claim 1 is, therefore, believed to be allowable, at least for this reason.

The Advisory Action cites col. 7, ll. 20-27, and col. 2, ll. 26-49, of Freeman, among others, for this teaching. At the cited locations, Freeman teaches various steps in verifying medical insurance coverage and processing claims. Nowhere does Freeman teach that a financial transaction processing computer is used to accomplish any of this. In fact, the Advisory Action includes the statement, “the invention disclosure by Freeman is interpreted by the Examiner as a financial transaction processing computer it that it . . . authorizes the transfer

of funds which reads on financial transaction processing computer.” This is an improper interpretation. Authorizing the transfer of funds and processing financial transactions are not the same.

In an attempt to cure this, the Advisory Action points to the central brokerage computer of Pritchard as being a financial transaction processing computer. The language of Pritchard describing this function makes it clear that the central brokerage computer of Pritchard does not actually process the transaction as the Applicants claim (see, col. 9, ll. 42-49, “But, if the insurance claim assignment provision is invoked by the patient for payment directly to the service provider 16, the insurance carrier, such as 36, can effect an electronic funds transfer by means of a communication to either a bank 40, which serves the service provider 16, or to the institution 42, which has an account for the service provider 16.”) Taken as a whole, it is clear that Pritchard does not, in fact, teach a financial transaction processing computer but, instead, teaches an information management computer that may notify the various parties how funds should be transferred. Hence, the rejection of claim 1 is believed to be improper.

Even if the rejection of claim 1 is maintained, however, the rejection of claim 2 is improper because claim 2 makes it clear that the financial transaction processing computer is a credit card processing system. The cited references do not teach or suggest “wherein the financial transaction processing computer system comprises a credit card processing system.” The Office Action cites Freeman for this teaching. At the cited location, however, Freeman refers to swiping a patent ID card through a “credit card type machine.” This fails, however, to teach or suggest that the “financial transaction processing computer system” (i.e., the bank terminal on the other end of the network) is a credit card processing system. “Credit card type machine(s)” may be configured to dial a variety of systems; to assume that such a machine at a doctor’s office necessarily contacts a credit card processing system is an invalid assumption. Hence, claim 2 is believed to be allowable, at least for this additional reason.

Claim 3 is believed to be allowable for the additional reason that the cited references do not teach or suggest “wherein the member identifier is received in credit card number format.” The Office Action cites Pritchard for this teaching, but nowhere does Pritchard teach or suggest that the identifier is received in credit card number format.

Similarly, claim 5 is believed to be allowable for the additional reason that the cited references do not teach or suggest that the “individual code is received in a format relating to currency.” The Office Action states that the Examiner interprets the code in currency format to represent a symbol which, according to the reasoning of the Office Action, may be replaced “without changing the scope of the invention.” The Applicants are unable to find rational for this rejection in the guidelines. It appears that the Office Action is stating that Freeman, in fact, does not teach or suggest the element, in which case, the rejection is invalid. Hence, claim 5 is believed to be allowable for this additional reason.

Claim 11 includes the element, “entering member information into a credit card processing device.” This is not taught or suggested by the cited references. A credit card type machine is not a credit card processing device. Hence, the rejection of claim 11 is improper.

Claim 12 is believed to be allowable for additional reasons similar to claim 5. Claim 12, however, recites that the “identifier information comprises an individual code in a currency field,” thereby further distinguishing claim 12 from the cited references.

Claim 17 is believed to be allowable because the cited references do not teach or suggest “an account number in credit card format” and “a list of covered members.” Pritchard is cited for the credit card number format, but does not address the format of the number being credit card format, even though the card may be like a credit card. In fact, Pritchard depicts (Fig. 2, ref no. 18) a number NOT in credit card format. Hence, Pritchard appears to teach away from the invention. Doyle is cited for the list of covered members, but Doyle does not teach or suggest that the list is actually on the credit card as the claim recites. Hence, claim 17 is believed to be allowable, at least for this additional reason. Claim 18 depends from claim 17 and is believed to be allowable, at least for the reason stated above.

Claim 19 is believed to be allowable because the cited references do not teach or suggest assigning codes to covered dependents that are in currency format. The Examiner credits this to Doyle without giving patentable weight to the currency format element. This allows a credit card processing network to be used to receive dependent information, and the element should be given patentable weight.

Claim 20 recites placing the dependent codes on the card, thereby further distinguishing claim 20 from the cited references. Claim 21 depends from claim 19 and is believed to be allowable, at least for the reasons stated above.

Claim 22 is believed to be allowable because the cited references do not teach or suggest a host computer system that is “programmed to receive insurance information from a point-of-sale device via the credit card processing network and verify coverage.” The Office Action does not specifically address the use of a credit card processing network through which insurance information is received. Hence, claim 22 is believed to be allowable, at least for this additional reason.

Claims 23-27 depend from claim 22 and are believed to be allowable, at least for the reason stated above.

The remaining claims depend from one of the independent claims discussed above and are believed to be allowable, at least for the foregoing reasons.

Conclusion

In view of the foregoing, the Applicants respectfully request withdrawal of the rejections and issuance of a formal Notice of Allowance.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: April 29, 2008

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